

REMARKS

Entry of the above amendments and reconsideration and withdrawal of the rejections are respectfully requested.

Please find attached hereto a copy of the references listed on the Information Disclosure Statement filed September 5, 1997. The original documents must have gotten lost in the mail.

Support for the language in new claims 42 and 43 can be found in the last two paragraphs on page 3 of the specification.

The rejection of claims 1-41 under 35 USC 112, first paragraph, as being non-enabling is traversed. The term "aryl" is a word of art that is known and used and is defined not only in chemical dictionaries but also in non-technical dictionaries such as Webster's Ninth New Collegiate Dictionary where on page 106 "aryl" is defined as "a radical (as phenyl) derived from an aromatic hydrocarbon by the removal of one hydrogen atom." The Condensed Chemical Dictionary, eighth edition, defines an "aryl compound" as "a compound whose molecules have the ring structured characteristic of benzene, naphthalene, phenanthrene, anthracene, etc., i.e., either the six carbon ring of benzene or the condensed six-carbon rings of the other aromatic derivatives. For examples, an aryl radical might be phenyl, C_6H_5- ; benzyl, $C_6H_5CH_2-$; naphthylene, $C_{10}H_6=$; etc." Hence, the term "aryl" is a term of art that is very enabling not only to scientist but also to layman as defined above in Webster's dictionary. The Examiner is respectfully requested to withdraw this rejection.

The rejection of claims 1-41 under 35 USC 112, second paragraph, as being indefinite is traversed. The Examiner questions how a straight or branched chain alkyl moiety having 3-6 carbons differs from an alkyl having 3-6 carbons. It is well known in the interpretation of claim language that the broader the language the broader the

inclusion. In other words, the less you say in the claims the broader the inclusion. Hence, applicant agrees with the Examiner that this language is the same. However, in preparing the claim an inadvertence occurred in that a species was included as a member in the Markush group along with subgeneric terms; all of the members of a Markush should be at the same level, that is, either all species or all subgeneric terminology. Hence, the species member 3-alkoxy-2-hydroxypropyl group has been deleted from claim 1 and has been added as new claim 44. Now, all of the members of the Markush group are at the same class or level, i.e., all subgeneric. This amendment eliminates the confusion due to overlapping.

Antecedent basis has now been added to claim 1 to support the language "the hydrophilic portion". It should be noted that this language is inherent because by definition all water-soluble polysaccharide polymers must have a hydrophilic portion in order to be water-soluble.

In claim 3, the spelling of "zwitterionic" has been corrected. Concerning the term "lower alkanols", it is a term of art that traditionally has 1 to 6 carbons. Applicant gives an example of "ethanol" which is in the middle of the range. It is submitted that a person having a skill in the art would know exactly what alkanols would be included in the group of "lower alkanols". The Markush language of claim 8 has been corrected as suggested by the Examiner. Hence, this rejection should be withdrawn.

The rejection of claims 1-8 and 10 under 35 USC 102 (b) as being anticipated by Angerer ('733) is traversed. Applicant invention is directed to a personal care composition of a vehicle system comprising a hydrophobically modified nonionic water-soluble polysaccharide polymer and at least one other personal care ingredient. Angerer does not disclose applicant's invention. Angerer discloses an aqueous protective coating composition comprising 3-alkoxy-2-hydroxypropyl hydroxyethylcellulose where the alkyl has 6-24 carbons. This polymer is an associative thickener that is associative and primarily used in paints. On the other hand, applicant's polymer has 2-6 carbons, which makes it a non-associative polymer that has radically

different rheological properties that produce different functional properties when included in personal care formulations.

Moreover, Angerer does not disclose at least one other personal care ingredient for a personal care composition. Angerer discloses a latex paint composition that is significantly different from a personal care composition. Hence, applicant denies the contentions:

"All of the limitations of the above listed claims are met by Angerer. The phrase "a personal care composition" provides no patentable distinction as all components of the composition are taught by Angerer."

Concerning the Examiner's contention that the rejection is being maintained because the intended use in the preamble of the claimed composition is not given patentable weight, applicant denies this contention. The rules and statutes as well as the case law are quite clear that when a claim includes components of a particular product, i.e., cosmetic or personal care product, and refers back to the preamble, then those claims are use type claims for that particular use or product. In other words, since applicant's claims contain at least one ingredient of a cosmetic or personal care formulation as well as the water-soluble polymer, these claims are such specific formulation claims and cannot be mistaken for latex paint formulations.

On the subject of the preamble, the Federal Circuit in Corning Glass Works v. Sumitomo Electric U.S. A., Inc. (9 USPQ2d 1962, Fed. Cir. 1989) said that:

"No litmus test can be given with respect to when the introductory words of a claim, the preamble, constitute a statement of purpose for a device or are, in themselves, additional structural limitations of a claim. To say that a preamble is a limitation if it gives "meaning to the claim" may merely state the problem rather than lead one to the answer. The effective preamble language can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim."

In the Angerer patent, the specification makes it clear that the inventor was working on latex paint formulations. Applicant makes it quite clear that he is dealing with cosmetics or personal care formulations. To read the claims of the Angerer patent in light of the specification indiscriminately to cover all types of formulations would be divorced from reality. The invention is restricted to latex paint formulations as defined in the specification which is significantly different from what applicant's invention intends. Hence, the claimed preamble as well as the ingredients in the claim limitations of the instant invention defines a specific and definite use that is non-analogous to that of Angerer. Therefore, Angerer clearly does not anticipate applicant's invention.

The rejection of claims 1-8 under 35 USC 102 (b) as being anticipated by Sau ('772) is traversed. The Sau reference is akin to the Angerer reference mentioned above. Sau discloses a mixed hydrophobe polymer with at least two hydrophobic radicals where one can be 3-alkoxy-2-hydroxypropyl hydroxyethylcellulose where the alkyl has 6-24 carbons. Again, this is a long chain alkyl group as opposed to a short chain alkyl group, which means that Sau is an associative thickener while the instant invention is not an associative thickener. These polymers are simply different. Moreover, Sau has an enabling disclosure only for latex paints. Although there is a disclosure in column 10, in lines 10-13, that among other uses this invention may be used as a thickener in cosmetics and shampoos, the patent does not teach or enable a person skilled in the art how to practice this invention for cosmetics and shampoos. As stated above, this mixed hydrophobe polymer with the long chain alkyl group is associative and was designed basically for paints. Such associative thickeners impart

radically different rheological properties in personal care formulations than the polymers of this invention. This patent simply does not enable a person having an ordinary skill in the art how to practice Sau's invention in the cosmetic or shampoo formulations. It must be reiterated and it is well known in the art that associative thickeners cannot be used in the same manner as non-associative thickeners or perform the same function. It would take undue experimentation of a person having an ordinary skill in the art to make the mixed hydrophobe polymers of Saul function in personal care formulations. For these reasons, Sau clearly does not anticipate the instant invention.

The rejection of claims 1, 8, and 9 under 35 USC 102 (b) as being anticipated by t'Sas ('207) is traversed. This reference does not disclose applicant's invention. This reference discloses a new non-ionic water-soluble cellulose ether polymer (i.e., 3-alkoxy-2-hydroxypropyl hydroxyethylcellulose where the alkyl has 1-10 carbons) that is used in building compositions. Although this water-soluble cellulose ether is a non-associative thicker at the lower end of the range for the alkyl group being 1-10, it still does not disclose applicant's invention of a use in a personal care composition. As disclosed above, the present invention is directed to a use composition of a personal care composition that not only must include a polysaccharide polymer that can be a cellulose ether, but it must also include at least one other personal care ingredient. The arguments set forth above concerning preambles and use type claims are repeated herein. Hence, this t'Sas patent clearly does not anticipate applicant's invention.

The rejection of claims 11-41 under 35 USC 103 (a) as being unpatentable over Angerer or Sau is traversed. The arguments set forth above concerning these references are repeated herein. Applicant agrees with the Examiner that these references do not disclose a shampoo, conditioner, sun care product, shower gel, soap, etc, but denies the following contentions:

"However, it would have been obvious to one of ordinary skill in the art to use the compositions of either Angerer or Sau in the above listed formulations as it is well known in "personal care" industry to utilize rheological agents, surfactants, solvents, etc. No patentable distinction is seen in the use of an old composition in a "personal care" setting lacking evidence of criticality attributed thereto."

It is not understood what teaching in the Angerer reference that the Examiner is basing his assertion of obviousness or what prior knowledge that the Examiner is using to make this contention. Please point out in the Angerer reference what language he is referring to say that a paint composition can be used for a personal care formulation. If the Examiner is using prior knowledge of his own, he needs to make a declaration thereto so that it can be contested herein. If, on the other hand, the Examiner is relying on a secondary reference, he should cite it here so that applicant can investigate it. In the absence of any of these things, it is submitted that it would not be obvious to use Angerer in personal care compositions. Moreover, as pointed out above, Angerer is directed to the use of an associative thickener since the alkyl group in the hydrophobic group would have 6 to 24 carbons while the claims of the instant invention would have 2-6 carbons. The criticality is that applicant is using a non-associative thickener that has never been used before in personal care products and has illustrated this point many times in the numerous examples set forth in the specification. Hence, a person skilled in the art armed with this patent would not be able to practice applicant's invention because there is nothing in the reference or any secondary teaching that would lead him to use the teaching of Angerer in a personal care formulation.

Concerning the Sau patent, although it discloses in column 10, in lines 10-13, that its mixed hydrophobe polymers can be used in "cosmetics and shampoos", the patent does not enable a person having an ordinary skill in the art to practice the Sau mixed hydrophobe polymers in either cosmetics or shampoos. Also, the Sau mixed hydrophobe polymers are substantially associative in nature and therefore, would impart radically different rheological and functional properties to a cosmetic or shampoo than the non-associative polymers of this invention. Hence, a person having an ordinary skill

in the art armed with Sau would not be able to practice applicant's invention in view of the above arguments.


The rejection of claims 14-18, and 21-41 under 35 USC 103 (a) as being obvious over t'Sas is traversed. The arguments set forth above concerning this reference are repeated herein. Applicant agrees with the Examiner that the t'Sas reference does not disclose a shampoo, conditioner, sun care product, shower gel, soap, etc, but denies the following contentions:

"However, it would have been obvious to one of ordinary skill in the art to use the compositions of t'Sas in the above listed formulations as it is well known in "personal care" industry to utilize rheological agents, surfactants, solvents, etc. No patentable distinction is seen in the use of an old composition in a "personal care" setting lacking evidence of criticality attributed thereto."

Again, it is not understood what teaching in the t'Sas reference that the Examiner is basing his assertion of obviousness or what prior knowledge that the Examiner is using to make this contention. Please point out in the t'Sas reference what language he is referring to say that a building composition can be used as a personal care formulation. If the Examiner is using prior knowledge of his own, he needs to make a declaration thereto so that it can be contested herein. If, on the other hand, the Examiner is relying on a secondary reference, he should cite it here so that applicant can investigate it. In the absence of any of these things, it is submitted that it would not be obvious to use t'Sas in personal care compositions. The criticality is that applicant is using a non-associative thickener that has never been used before in personal care products and has illustrated this point many times in the numerous examples set forth in the specification. Hence, a person skilled in the art armed with this patent would not be able to practice applicant's invention because there is nothing in the reference or any secondary teaching that would lead him to use the teaching of t'Sas in a personal care formulation.

For the reasons set forth above, it is submitted that this application is now in condition for allowance and prompt notification thereof is respectfully requested.

Respectfully submitted,



David Edwards
Reg. No. 27,293

Hercules Incorporated
Intellectual Property Section
1313 North Market Street
Wilmington, DE 19894-0001
(302) 594-6974

September 17, 1998